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### REMARKS

Claims 1-38 are all of the claims presently pending in the application. Claims 1-2, 7, 11-12, 20, 29, and 31 have been amended to more particularly define the invention.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner which would require further consideration and/or search.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chefalas et al. (U.S. Patent Application Publication No. 2002/0138786) (hereinafter "Chefalas"). Claim 31 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

This rejection is respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention (e.g., defined by claim 1) is directed to a method of reducing warranty costs. The method includes monitoring indicators in a computer system, discriminating between a hardware-induced outage and a software-induced outage in the computer system based on the indicators, and periodically storing the indicators prior to the problem or outage.

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Conventional computer system diagnosis methods (e.g., see "Background" section of the Application at pages 1-3) include diagnosing a computer system outage after the outage occurs. Typically, when a customer experiences an outage event with a computer system, the customer or field service engineer does not know whether the event was caused by a hardware problem or a software problem. It is well known that many outages in computer systems are software-induced. However, when it is not possible to discriminate between a software-induced outage and a hardware-induced outage, the customer or field service engineer often assumes that the problem is due to hardware, in which case the hardware is returned to the manufacturer. This results in a large amount of non-defective hardware being erroneously returned to the manufacturer. When this occurs, unnecessary service costs are incurred by the manufacturer. Additionally, when a customer or field service technician is unable to determine if a outage was software-induced or hardware-induced an additional unnecessary cost is incurred by the service technician who must execute a lengthy diagnosis procedure.

The claimed invention of exemplary claim 1, on the other hand, provides a method of reducing warranty costs. The method includes periodically storing the indicators prior to the problem or outage (see e.g., Application at page 8, line 10 through page 9, line 21). This feature allows the claimed invention to collect pre-outage data as well as post-outage data, automatically identify system outages and automatically determine whether the outage was due to the hardware or the software while limiting the amount of unnecessary service calls and unnecessary hardware replacements (see e.g., Application at page 3, lines 15-20).

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## II. NON-STATUTORY SUBJECT MATTER REJECTION

The Examiner has rejected claim 31 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner alleges that the preamble must consist of a “computer-readable medium storing computer-readable instructions, which are executable to perform the desired method”.

Applicants submit that a “computer program embodied in a tangible medium, such as a floppy diskette, are patentable subject matter under 35 U.S.C. §101, and must be examined under §§102 and 103”, *Beauregard, In re* 53 F.3d 1583, 35 U.S.P.Q. 2d 1383. The claimed invention of exemplary claim 31 recites, inter alia, “[a] signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method for reducing warranty costs” (emphasis Applicants’).

Applicants respectfully submit, that the claimed invention (as exemplarily defined by claim 31) is directed to a tangible medium that can be used to direct a digital processing apparatus (such as a computer) to function in a particular manner when used by the digital processing apparatus. The claim language clearly states, in the preamble, that the program of machine-readable instructions is executable by a digital processing apparatus to perform the inventive method of the claimed invention. Furthermore, this program of machine-readable instructions is stored on a tangible medium.

It appears that the Examiner has rejected claim 31 because the preamble recites “a signal-bearing medium”. Applicants respectfully submit that such a “signal-bearing medium” is a tangible medium such as a floppy diskette, CD-ROM, etc. as is disclosed in the specification.

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In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

### III. THE PRIOR ART REFERENCE

The Examiner alleges that Chefalas teaches the claimed invention of claims 1-38. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by Chefalas.

That is, Chefalas does not teach or suggest "*periodically storing the indicators prior to the problem or outage*" as recited in claim 1 and similarly in claims 7, 11, 15, 20, 29 and 31.

The Chefalas patent describes a software agent that, once a problem has been detected, creates a list of hardware on the system and a list of software on the system (see e.g., Chefalas at paragraphs [0035]-[0036]).

For the hardware items, it "performs a status check by polling or querying each device regarding its status of operations." For the software items, it "scans event and application logs for the software applications" in order to determine whether they have emitted any error events.

Clearly, the novel features of the claimed invention are not taught or suggested by Chefalas. The Examiner attempts to rely on paragraphs [0031] - [0037] of Chefalas to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in these passages (nor anywhere else for that matter) does Chefalas teach or suggest a method of reducing warranty costs including periodically storing said indicators prior to the problem or outage. In other words, the claimed

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invention teaches creating a log, before the problem or outage, which may be used to determine whether the problem or outage was due to hardware or software.

Chefalas, on the other hand, merely teaches reading logs that are previously collected by other entities (see paragraph [0036]). Chefalas does not teach or suggest creating a log or otherwise storing data, let alone doing so prior to the problem or outage (or the "event" as in other independent claims) as taught by the claimed invention.

Moreover, nowhere does Chefalas teach or suggest that *"if the outage event comprises a software outage or problem, determining whether automatic recovery is possible, and if so, invoking an automatic recovery mechanism and notifying a customer or field support personnel that said software outage or problem is the cause of the event, and identifying a faulty subsystem for subsequent troubleshooting"* or that *"if the event the outage event comprises a software outage or problem, determining whether automatic recovery is possible, and if not, indicating that the event is due to said software outage or problem, and is not automatically recoverable, and notifying a customer or service technician to manually recover the fault"* as recited in dependent claims 16 and 17, respectively.

The Examiner has rejected claim 16 by stating that Chefalas teaches that the software agent determines whether automatic recovery is possible, and if so, invokes an automatic recovery mechanism. The Chefalas patent, however, is oriented around automated discrimination but manual repair of problems, by a user who is looking at a web page.

The claimed invention of dependent claims 16 and 17, on the other hand, defines a fully automated solution, and teaches automatic recovery without any user intervention.

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if the problem is so diagnosed as being an automatically recoverable software problem.

One example of such a recoverable software fault is a resource exhaustion problem (e.g., memory leak), where the system can recover by stopping and restarting the software that is causing the memory leak (Note that the data sources described by Chefalas are inadequate to detect this type of problem). Only if the automatic recovery is not possible, or if it is determined that it is a hardware problem, is the user contacted. This is a significant extension to Chefalas because it uses the analytical capability described in the application to completely avoid a service call.

Indeed, Chefalas merely teaches a system and method for supporting one or more registered products at a computing device where the computing device is enabled to communicate with a support web server. In Chefalas, once a user detects a computer system problem or outage the user must contact the support web server. Once the user loads the web page for product support the user selects a "diagnose" button on the web page for diagnosing the user's computer device that has failed to operate in an expected manner. The web server then uploads onto the user's computing device a software agent for diagnosing the cause of the computer system problem or outage (see Chefalas at page 3, paragraph [0028]).

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggest by Chefalas. Therefore, the Examiner is respectfully requested to withdraw this rejection.

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#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-38, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

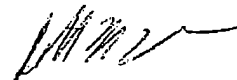
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to  
credit any overpayment in fees to Assignee's Deposit Account No. 50-0510

Respectfully Submitted,

Date: December 13, 2004

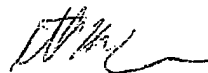
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment by facsimile with the United States Patent and Trademark Office to Examiner Christopher S. McCarthy, Group Art Unit 2113 at fax number (703) 872-9306 this 13<sup>th</sup> day of December, 2004.



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